

200316700-1

10/825,870

REMARKS

This is a full and timely response to the non-final Official Action mailed February 8, 2007. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Claims 22-53 and 63-79 were withdrawn from consideration under the imposition of a previous Restriction Requirement. Applicant hereby affirms the election of claims 1-21 and 54-62.

To expedite the prosecution of this application, withdrawn claims 22-53 and 63-79 are cancelled by the present paper. The withdrawn claims are cancelled without prejudice or disclaimer. Applicant reserves the right to file any number of continuation or divisional applications to the withdrawn claims or to any other subject matter described in the present application.

By the forgoing amendment, various claims have been amended. Additionally, claims 59 and 61 have been cancelled without prejudice or disclaimer, and new claims 80-99 have been added. Thus, claims 1-21, 54-58, 60, 62 and 80-99 are currently pending for further action.

35 U.S.C. § 112, Second Paragraph:

The outstanding Office Action rejected claims 2, 9, 12, 21 and 55 under 35 U.S.C. § 112, second paragraph. These claims have been carefully reviewed in light of the Examiner's comments. While Applicant does not necessarily agree that any of the listed claims were indefinite as filed under 35 U.S.C. § 112, second paragraph, to expedite the prosecution of

200316700-1

10/825,870

this application, each of the claims has been amended for clarity as suggested by the Examiner. Applicant further notes that the amendments made in this regard are made solely to clarify the language of the claims and do not, and are not intended to, narrow the scope of the amended claims in any degree. Following this amendment, claims 2, 9, 12, 21 and 55 are believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

Prior Art:

Claims 1-7, 9-15, 21, 54-56 and 58-60 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,962,715 to Lee et al. ("Lee"). This rejection is respectfully traversed for at least the following reasons.

Claim 1 recites:

A method for producing an oral medication comprising:
with an inkjet dispenser, dispensing a structural material, said structural material including one of a polymer or a gelatin;
curing said structural material; and
dispensing a jettable pharmaceutical solution onto said *cured* structural material.
(Emphasis added).

Support for the amendment to claim 1 can be found in Applicant's originally filed specification at, for example, paragraph 0021.

Applicant notes that claim 1 now recites dispensing a structural material with an inkjet dispenser and then curing the dispensed structural material. After the structural material is cured, claim 1 recites "dispensing a jettable pharmaceutical solution onto said *cured* structural material." (Emphasis added).

In contrast, Lee fails to teach or suggest any of this subject matter. Lee does not teach or suggest dispensing a structural material with an inkjet dispenser and then curing the

200316700-1

10/825,870

dispensed structural material. Lee does not teach or suggest "dispensing a jettable pharmaceutical solution onto said *cured* structural material." (Emphasis added).

According to the Office Action, Lee teaches "dispensing or ejecting (col. 12, lines 27-32) fluid drops of a barrier material, i.e., structure material, over the bioactive fluid, i.e. pharmaceutical solution, deposits on the ingestible sheet." (Action of 2/28/07, p. 5). While this appears to be an accurate statement of what Lee teaches, it has nothing to do with the claimed subject matter.

Lee does not teach or suggest that the barrier material, which the Action equates to the claimed structural material, is cured. Lee does not teach, suggest or even mention curing a structural material as recited in claim 1.

Moreover, Lee teaches, as indicated in the Office Action, that the barrier material is dispensed "over the bioactive fluid, i.e. pharmaceutical solution." (*Id.*). This is the opposite of claim 1, which recites that the structural material is deposited first, cured and then the pharmaceutical solution is deposited on the *cured* structural material. Lee does not teach or suggest any of this subject matter.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Thus, for at least these reasons, the rejection based on Lee of claim 1 and its dependent claims should be reconsidered and withdrawn.

200316700-1

10/825,870

Independent claim 54 recites:

A method for forming a slow release dosage of oral medication comprising:
disposing a first layer of polymer based structural material adjacent to an inkjet dispenser;

jetting a jettable pharmaceutical solution onto said polymer based structural material with said inkjet dispenser, *wherein said solution comprises a solvent for dissolving said solution into said structural material.*

(Emphasis added).

Support for the amendment to claim 54 can be found in Applicant's originally filed specification at, for example, paragraph 0033 and Figs. 7 and 9.

In contrast, Lee fails to teach or suggest the claimed method including "jetting a jettable pharmaceutical solution onto said polymer based structural material with said inkjet dispenser, *wherein said solution comprises a solvent for dissolving said solution into said structural material.*" (Emphasis added). "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Lee of claim 54 and its dependent claims should be reconsidered and withdrawn.

Claims 1, 8, 10, 11 and 14-20 were rejected as being anticipated by U.S. Patent No. 4,197,286 to Sturzenegger et al. ("Sturzenegger"). For at least the following reasons, this rejection is respectfully traversed.

As indicated above, claim 1 recites:

A method for producing an oral medication comprising:
with an inkjet dispenser, dispensing a structural material, said structural material including one of a polymer or a gelatin;
curing said structural material; and

200316700-1

10/825,870

dispensing a jettable pharmaceutical solution onto said *cured* structural material.
(Emphasis added).

In contrast, Sturzenegger does not teach or suggest the claimed method in which an inkjet dispenser dispenses a structural material that is then cured to receive a dispensed pharmaceutical solution.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Thus, for at least these reasons, the rejection based on Sturzenegger of claim 1 and its dependent claims should be reconsidered and withdrawn.

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

Claim 15 depends, ultimately, from claim 1 and recites "wherein said solvent is configured to dissolve said oral drug component." Claim 16 similarly recites "wherein said solvent is configured to partially dissolve said structural material." In contrast, neither Lee nor Sturzenegger teach or suggest this subject matter. For at least these additional reasons, the rejections of claims 15 and 16 should be reconsidered and withdrawn.

Claims 11-20 and 60-62 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Lee and U.S. Patent No. 6,602,511 to Von Corswant. This rejection is improper and respectfully traversed under 35 U.S.C. § 103(c).

200316700-1

10/825,870

35 U.S.C. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicant notes that Lee is available as prior art against the present application only under 35 U.S.C. § 102(e). The Office also recognizes this fact as Lee was elsewhere applied by the outstanding Office Action under § 102(e). (Action of 2/8/07, p. 5).

Applicant also notes that Lee is assigned to the Hewlett-Packard Co. as shown on the cover of the patent. Similarly, the present application is also assigned to Hewlett-Packard Co. (See, recorded assignment at reel/frame 015225/0377).

Applicant hereby states that the subject matter of the present application and the Lee reference were, at the time the invention of the present application was made, owned by, or subject to an obligation of assignment to, the same person, i.e., Hewlett-Packard Co. (See MPEP § 706.02(I)(2)).

Consequently, under 35 U.S.C. § 103(c), the Lee reference *cannot* be applied as prior art against the present application under 35 U.S.C. § 103(a). Therefore, the listed rejections of claims 11-20 and 60-62, which apply Lee under § 103(a), must be reconsidered and withdrawn.

200316700-1

10/825,870

Conclusion:


The newly added claims are thought to be patentable over the prior art of record for at least the same reasons given above with respect to the original independent claims.

Therefore, examination and allowance of the newly added claims is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: May 8, 2007



Steven L. Nichols
Registration No. 40,326

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number **571-273-8300** on **May 8, 2007**. Number of Pages: **21**


Rebecca R. Schow